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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,742	11/28/2000	John S. Hendricks	026880.00021	6312
4372	7590	04/13/2006	EXAMINER	
ARENT FOX PLLC 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			GEREZGIHER, YEMANE M	
			ART UNIT	PAPER NUMBER
			2144	

DATE MAILED: 04/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/722,742

Applicant(s)

HENDRICKS, JOHN S.

Examiner

Yemane M. Gerezgiher

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-20 and 22-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-20 and 22-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The response received on 02/01/2006 has been entered. Claims 1-9, 11-20 and 22-29 remain pending in this application.

Response to Arguments

2. Applicant's arguments filed 02/01/2006 have been fully considered but they are not persuasive.

The inventive entity argues that the claimed limitation of “a controller preventing the viewer from receiving/downloading additional electronic books from the file server when a number of e-books stored on the viewer exceeds a maximum number” been supported by the original specification. The inventive entity points to a paragraph on page 24 lines 14-17 (Applicant’s Remark on Page 9, ¶1).

However, the examiner respectfully disagrees with that contention. Quite contrary to the claimed limitation, the inventive entity point to the section in Specification, Page 24, Lines 14-17 (“...it is preferred that the public viewer 912 be limited to receiving one or two books at a time from the controller 908.

When the user of the public viewer 912 needs a new or additional book he returns the viewer 912 to the library where he receives a new book from the controller 908”).

The examiner note that there is **no functional limitation that prevents the viewer from downloading e-books based on a defined set of “maximum”** number of books further including no design of realizing, knowing or identifying how many e-books the viewer actually might have already downloaded. Thus, the examiner maintains his position that there is no written support in the specification that fully supports the alleged functional limitations as recited in the claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-9, 11-20 and 22-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 16 and 24 now recite the following functional limitation:

... wherein the controller prevents the viewer from receiving additional electronic books from the file server when a number of electronic books stored on the viewer exceed a maximum number.

This limitation is not disclosed or described in the present specification.

This application benefits a priority of an earlier filing date as a continuation of application number 09/237825, filed on Jan. 27, 1999, which is a divisional of application number 08/336247 filed on Nov. 7, 1994. However, there is no support in either one of the specifications of these applications. The inventive entity emphasizes a support to the recited limitation on page 24 lines 14-17. However, there is no functional limitation directed to preventing a viewer from receiving additional electronic books from the file server; there is no indication of predetermined maximum number of books and there is no step or a functional limitation that enables the controller that is used to determine what or how many books a viewer already received or downloaded by the viewer. Thus, the claimed limitation is not supported by the original specification.

Note: The patent law requires that applicant must disclose his invention in such detail that it will not require undue experimentation for one skill in the art. Applicant did not comply this requirement of the first paragraph. The examiner contends (at the time the invention was made) that it would require undue experimentation for one of ordinary skill in the art of electronic documents to make and use the claimed invention for the reasons set forth in

the claims. Applicant is reminded that no new matter is allowed in the amendment to the specifications under 35 U.S.C. 132 and 37 CFR 1.118(a).

Thus, claims 1-9, 11-20 and 22-29 are rejected, because the functional limitation disclosed above are not supported by the original and/or the present specification of the application.

However, for examination purpose, the examiner will reasonably interpret the limitation addressed above to mean that *the user the viewer bringing the viewer back to the source (file server OR e-library) for additional e-book by means of replacing an external memory mountable to the viewer or remotely connecting the viewer to the source via a telephone network or IR signal to store additional e-book on the server.*

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9, 11-14, 16-20, 24, 25 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warnock et al. (U.S. Patent Number

5,634,064) hereinafter referred to as Warnock in view of Tsuchiya (U.S. Patent Number 5,239,665)

As per claims 1, 16 and 24, Warnock Disclosed formation, delivery and presentation of electronic documents (journals articles and the like) and more particularly to the viewing of electronic documents at the user interface of the viewer viewing the selected documents (electronic documents selected from the provider and downloaded to a memory of the viewer/client) having therein a selector facilitating selection of desired electronic documents between the server providing the selected document and the viewer requesting the service. See ABSTRACT, Figure 3a, Column 1, Lines 10-20, Column 3, Lines 3-30 and Column 2, Lines 37-59. Warnock disclosed a reader/viewer digital computer system having therein a memory for storing the selected electronic documents (claim 3). See ABSTRACT and Column 14, Lines 49-65. Warnock further disclosed a system directed to digital processing system, the selector/controller having "software for controlling" (stored control programs and scripts) (claim 4) See Column 6, Lines 11-33. Warnock taught a controller having therein a viewing screen controlling the displayed electronic document (claims 6, 7 and 8). See Figures 1, 2 and 3a. Warnock also disclosed a printer connected to the digital computer/server printing electronic documents created and stored therein and printing the selected electronic documents based on displayed titles of the documents displayed for viewing by a client and printing the electronic documents by the printed connected to the system (claims 11-13 and

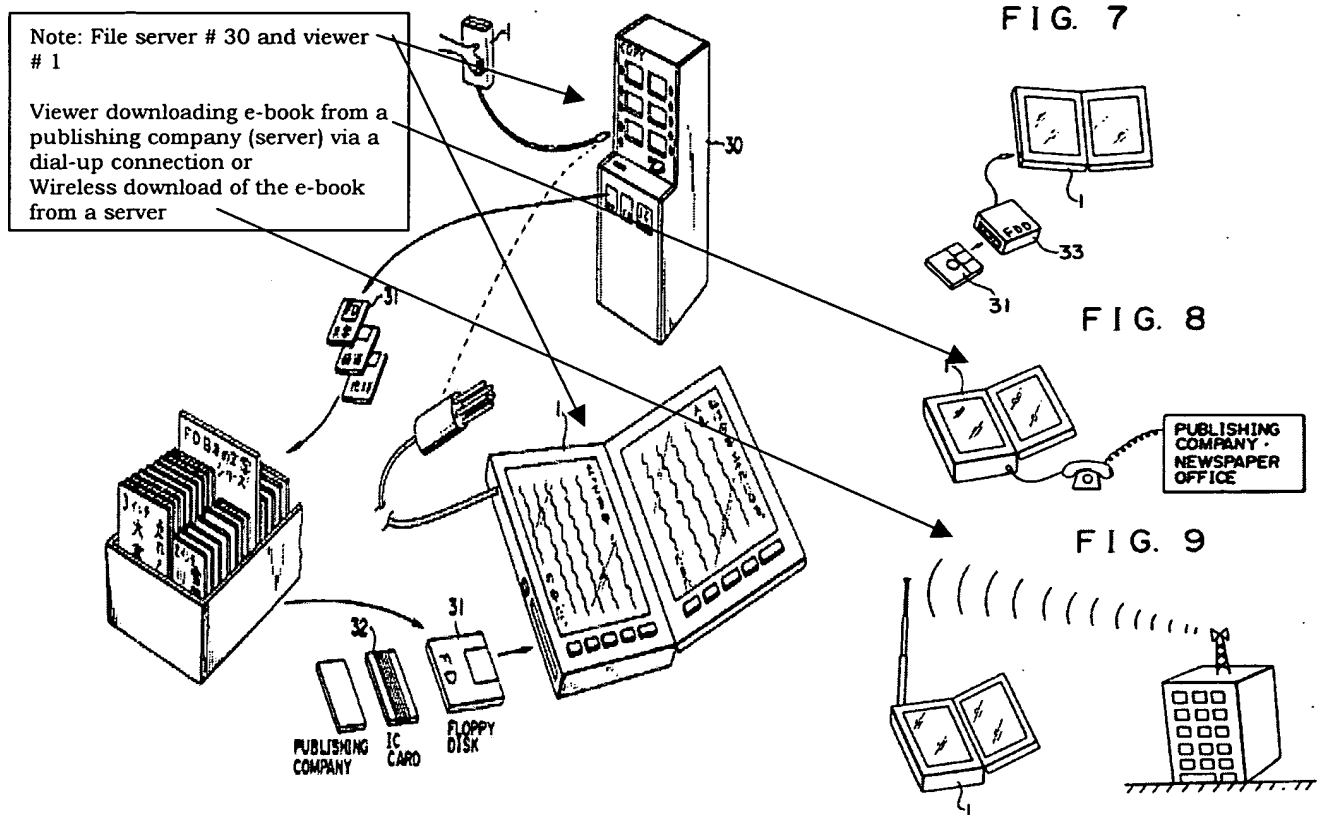
25). See Column 4, Lines 35-44, Column 5, Lines 47-62, Column 8, Lines 8-20, Column 10, Line 36 through Column 10, Line 17).

Warnock substantially disclosed the invention as claimed. Warnock disclosed a digital machine having therein a selector, a storage or server containing the electronic content and a user interface allowing the viewer to navigate through the desired electronic document. However, Warnock was silent about the selection of electronic documents in a network (at least two devices connected in some fashion and was silent about renewing or replacing or downloading additional electronic book/document from the file server.

However, as evidenced by Tsuchiya, transmitting electronic documents from server to a client via a third party or a controller or manager was known in the art at the time the invention was made. Tsuchiya disclosed a method of transmitting electronic books from a server ("file server") containing electronic books to an electronic book ("viewer") having therein user interface for displaying the content pages of the selected electronic book and downloading/storing the content on the electronic book on the memory of the client device ("viewer"). Tsuchiya disclosed a viewer accessing a single server which could store limited content of the electronic document/book (claim 9) recited, "Electronic books which are designed to obtain information via a telephone network...Pieces of information may be transferred directly and stored in the inner memory of the electronic book (claims 2, 17, 18, 27 and 28) via telephones and appropriate modems. Later, a reader can have access to a

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desired piece of information for display." See Figures 6-8 (also disclosed below), Column 6, Lines 7-16 and Column 6, Lines 45-54.



Furthermore, Tsuchiya disclosed a user the viewer bringing the viewer back to the source (file server OR e-library) for additional e-book by means of replacing an external memory mountable to the viewer or remotely connecting the viewer to the source via a telephone network or IR signal to store additional e-book on the server. See Tsuchiya, Abstract, Figs. 6, 8-9, Column 5, Lines 25-67, Column 6, Lines 19-54.

Thus, it is respectfully submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Tsuchiya related to transmitting electronic books on the Internet and the deleting stored documents at the client system in a specified period of time and converting video signal to an electronic signal and have modified the teachings of Warnock related to selecting and viewing electronic documents on a digital computer having therein a viewing display, because such a modification would protect proprietary rights of publishers and authors and allow a reader to have access to electronic documents/books that are remotely located on a server and would facilitate the distribution of electronic books widely (See Warnock, ABSTRACT and Figures 7-9).

3. Claims 15, 22, 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warnock et al. (U.S. Patent Number 5,634,064) hereinafter referred to as Warnock in view of Tsuchiya (U.S. Patent Number 5,239,665) further in view of what would have been obvious to one of ordinary skill in the art at the time the invention was made.

With respect to the rejection applied above, the combined teachings of Warnock and Tsuchiya substantially disclosed the invention as claimed. However, failed to teach deleting stored files after a specific periods of time from

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the client's memory and limiting access to file servers and converting video signal to electronic book/document as claimed in this invention.

Examiner takes Official Notice (see MPEP § 2144.03) that "deleting stored files after a specific periods of time from the client's memory (claims 22 and 26)

limiting access to file servers and controlling the number of electronic documents that could be downloaded by a client, converting a video signal to electronic document which could be displayed at a client's display (claims 15 and 23)" in a computer networking environment was well known in the art at the time the invention was made. For example, a Japanese Patent No.

JP405334167A entitled "NETWORK FILE SYSTEM MANAGING DEVICE"

disclosed deleting information stored (downloaded on the client system) at a determined period of time in accordance with information received ("A file deleting part 51 deletes a file included in the client computer in accordance with information stored in a deleting file information storing part 50"). See

ABSTRACT. Another example is Japanese Patent No. JP406068339A entitled "ELECTRONIC JOURNAL SYSTEM" issued to SATO, teaches converting a video signal to an electronic document/journal and displaying the converted electronic data at the client's display. See ABSTRACT. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03. However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a

reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, In re Boon, 169 USPQ 231, 234 states "as we held in Ahlert, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

4. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings which were well known in the art at the time the invention was made and have modified the already combined teachings of Tsuchiya related to transmitting electronic books on the Internet and Warnock related to selecting and viewing electronic documents on a digital computer in order to protect proprietary rights of publishers and authors by temporarily allowing clients to store and view electronic contents of interest.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply

is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Fernandez (US 4855725 A) entitled: "Microprocessor based simulated book". Fernandez disclosed a viewer downloading electronic book from a server, where the viewer (referred to as "the simulated book" or "CD book") stores limited number of electronic pages stored in a memory. Column 3, Lines 8-35 and Column 7, Lines 6-35 and Column 8, Lines 3-16.

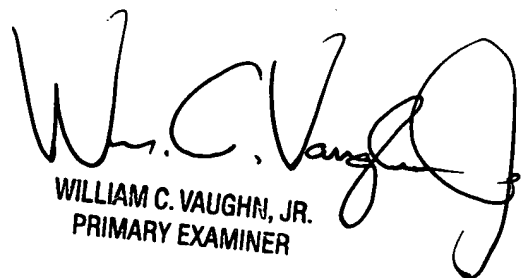
b. Shwartz et al. (US 5524201 A) entitled: "Method of preparing an electronic book for a computer system"

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yemane M. Gerezgiher whose telephone number is (571) 272-3927. The examiner can normally be reached on 9:00 AM - 6:00 PM Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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